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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/524,113

12/07/2005

Harlan A Hurwitz

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OLIFF & BERRIDGE, PLC

P.O. BOX 320850

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EXAMINER

SHAPIRO, JEFFERY A

ART UNIT

PAPER NUMBER

3653

NOTIFICATION DATE

DELIVERY MODE

02/19/2010

ELECTRONIC

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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<b>Office Action Summary</b>	<b>Application No.</b> 10/524,113	<b>Applicant(s)</b> HURWITZ ET AL.	
	<b>Examiner</b> JEFFREY A. SHAPIRO	<b>Art Unit</b> 3653	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 22 October 2009.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-11 and 13-20 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-11 and 13-20 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)            | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | Paper No(s)/Mail Date. _____                                      |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

## DETAILED ACTION

### ***Claim Rejections - 35 USC § 103***

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 1-7, 9-11 and 14-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Dobbins (US 2002/0063034 A1) in view of Jones (US 6,128,402) and further in view of Yokomori (JP402217987 A).

Regarding Claims 1, 16 and 19, Dobbins discloses the method and system of electronically managing a payment media exception processed from a payment media originating source, i.e., such as a cashier's cash drawer as mentioned at paragraph 3, first five lines, by a payment media handling apparatus, such as a bill acceptor (106), as mentioned in paragraph 32.

Dobbins further discloses Initiating a payment media acceptance operation using the payment media handling apparatus, i.e., such as mentioned in paragraphs 32 and 36, which mentions that cashiers who identify themselves or other persons with wireless ID tags, such as the store manager, may access the payment media handling apparatus.

Dobbins further discloses processing the at least one of the payment media determined to be unacceptable based upon instructions provided by a retail store. See

Dobbins at paragraph 49, last four lines, i.e., “many retailers require all \$50 and \$100 bills be dropped directly and immediately into the electronic safe...”

Dobbins does not expressly disclose, but Yokomori discloses a step of accepting a coin of a face value in which the face value is limited to be less than a preset cash value. See abstract and constitution of derwent translation.

Regarding Claims 1, 16 and 19, at the time of the invention, it would have been obvious to one of ordinary skill in the art to have accepted currency face values beneath a preset limit, as taught by Yokomori, in Dobbins' currency acceptor, since one ordinarily skilled in the art would have considered doing so for the predictable purpose of limiting the acceptance of larger size bills, as is customary in commerce as well as to improve the performance of determination of a false coin.

Regarding Claims 2, 17 and 20, note that the originating source is the cash till of a register from a retail store.

Regarding Claims 3 and 18, note that Dobbins disclose handling bills and checks at paragraph 49.

Regarding Claim 4, note that Dobbins discloses reporting various parameters and data regarding the transactions with the payment media handling device at figure 4 and at paragraph 5, for example.

Regarding Claim 5, Dobbins discloses damaged or worn bills at paragraph 29.

Regarding Claims 1, 16 and 19, Dobbins does not expressly disclose, but Jones discloses automatically determining if the payment media is in an acceptable or unacceptable condition. See Jones at col. 8, lines 35-53.

Regarding Claims 1, 16 and 19, at the time of the invention, it would have been obvious to one of ordinary skill in the art to have included a currency or bill acceptor as taught by Jones, in Dobbins' currency acceptor, since Dobbins' does not disclose details of such an acceptor, but suggests the use of an acceptor as taught by Jones. Further, Jones' device is disclosed at col. 3, lines 12-20 as rapidly processing bills. Thus, it would have been evident to one ordinarily skilled to incorporate Jones' bill acceptor into Dobbins' apparatus in order to rapidly process bills.

Regarding Claims 6-7, Jones further discloses notifying the user that the at least one payment media has been rejected by the currency handling device. See Jones at col. 8, lines 35-53, in which rejected bills are returned to the customer/user. Note that the act of returning the bills to the customer is construed as notification that the bills are unacceptable.

Regarding Claim 9, note that both Jones' and Dobbins currency handling devices are considered to be secure drop boxes.

Regarding Claim 10, note that Dobbins discloses placing payment media in an envelope at figure 2, for example.

Regarding Claims 11, Dobbins discloses providing information concerning the envelope of currency at paragraph 33.

Regarding Claim 14, note again that Dobbins discloses processing envelopes only from approved users with a user id such as a wireless device as described at paragraph 35 and processing only particular values of bills at paragraph 49.

Regarding Claim 15, Dobbins discloses notifying a supervisor at paragraphs 36, 38 and 44-46.

2. Claim 8 is rejected under 35 U.S.C. 103(a) as being unpatentable over Dobbins (US 2002/0063034 A1) in view of Jones (US 6,128,402), further in view of Yokomori (JP402217987 A), and still further in view of Jones (US 6,363,164 B1).

Dobbins discloses the system described above.

Regarding Claim 8, Dobbins does not expressly disclose, but Jones '164 discloses instructing the user to manually rearrange or reposition a portion of the currency that is determined to be unacceptable by the media handling apparatus, for the purpose of having the operator turn over reverse-faced bills that were unidentified and put them through the banknote validator a second time. See Jones at col. 63, lines 45-62 and col. 64, lines 55-63.

At the time of the invention, it would have been obvious to one of ordinary skill in the art to have instructed the user of Dobbins' currency acceptor to manually turn over reverse-faced bills and re-feed them through the bill validator, as taught by Jones, in Dobbins' currency acceptor, for the purpose of validating all bills in a stack, including those that are reverse-faced.

### ***Double Patenting***

3. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140

Art Unit: 3653

F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

4. Claims 1-11 and 14-20 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over Claims 1-20 of copending Application No. 10/524,109; Claims 1-19 and 21 of copending Application No. 10/524,110; Claims 1-19 and 24 of copending Application No. 10/524,111; Claims 1-18, 23 and 35 of copending Application No. 10/524,112; Claims 1-7, 9-10 and 12-14 of copending Application No. 10/933,289; and Claims 1-9, 11, 13-33, 35 and 37-45 of copending Application No. 11/117,563. Although the conflicting claims are not identical, they are not patentably distinct from each other because the independent claims of each of the mentioned applications embodies the subject matter of the Claims of the instant application. Specifically, these Claims recite a method of electronically managing a payment media exception processed from a payment media originating source by a payment media handling apparatus including the steps of initiating payment media acceptance using the payment media handling apparatus, automatically determining whether at least one of the payment media is in an unsuitable condition to be accepted by the media handling apparatus, and processing the at least one of the

payment media determined to be unsuitable based on rules in a lookup table, instructions from a user, instructions from a supervisor and instructions provided by an entity other than a retail store.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

### ***Response to Arguments***

5. Applicant's arguments with respect to Claims 1-11 and 14-20 have been considered but are moot in view of the new ground(s) of rejection.

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to JEFFREY A. SHAPIRO whose telephone number is (571)272-6943. The examiner can normally be reached on Monday-Friday, 9:00 AM-5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Patrick H. Mackey can be reached on (571)272-6916. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.



Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Jeffrey A. Shapiro/  
Primary Examiner, Art Unit 3653

February 10, 2010